REMARKS

Claims 1-5, 9, and 11-24 are pending. Claim 5 is amended to correct a minor informality. Claim 6 is canceled. Claims 11-24 are added. Support for new claims 11, 12, 17, 18, and 24 may be found on at least page 5, lines 9-16, and page 6, lines 4-14. Reconsideration of the claims is respectfully requested in view of the following remarks.

I. Telephone Interview

Applicants thank Examiner Du for the courtesies extended to Applicants' representative during the December 4, 2006, telephone interview. During the telephone interview, the above amendments and the distinctions of the claims over the cited art were discussed. Examiner stated that he will consider the amendments and perform an updated search. The substance of the telephone interview is summarized in the following remarks.

II. Non-Statutory Obvious-Type Double Patenting, Claim 1

The Office provisionally rejects claim 1 on the ground of non-statutory obvious-type double patenting over claim 1 of co-pending U.S. Patent Application No. 10/639,863 in view of *Benignus et al.* (U.S. Patent No. 4,888,771). This rejection is respectfully traversed.

The Office Action acknowledges that claim 1 of the '863 application does not recite the target state of at least one rule being a prerequisite for the target state of at least one further rule, and repeating the application of each failed rule to configure the subject entity according to the target state specified in the failed rule when all the corresponding prerequisite states are available. The Office Action alleges that *Benignus* teaches these features at col. 9, line 1, to col. 10, line 43. *Benignus* does not teach or fairly suggest repeating the application of each failed rule to configure the subject entity according to the target state specified in the failed rule when all the corresponding prerequisites are available, as recited in claim 1, for example. In fact, it appears that in *Benignus*, the logic stops testing whenever a test fails. FIG. 7 of *Benignus* is as follows:

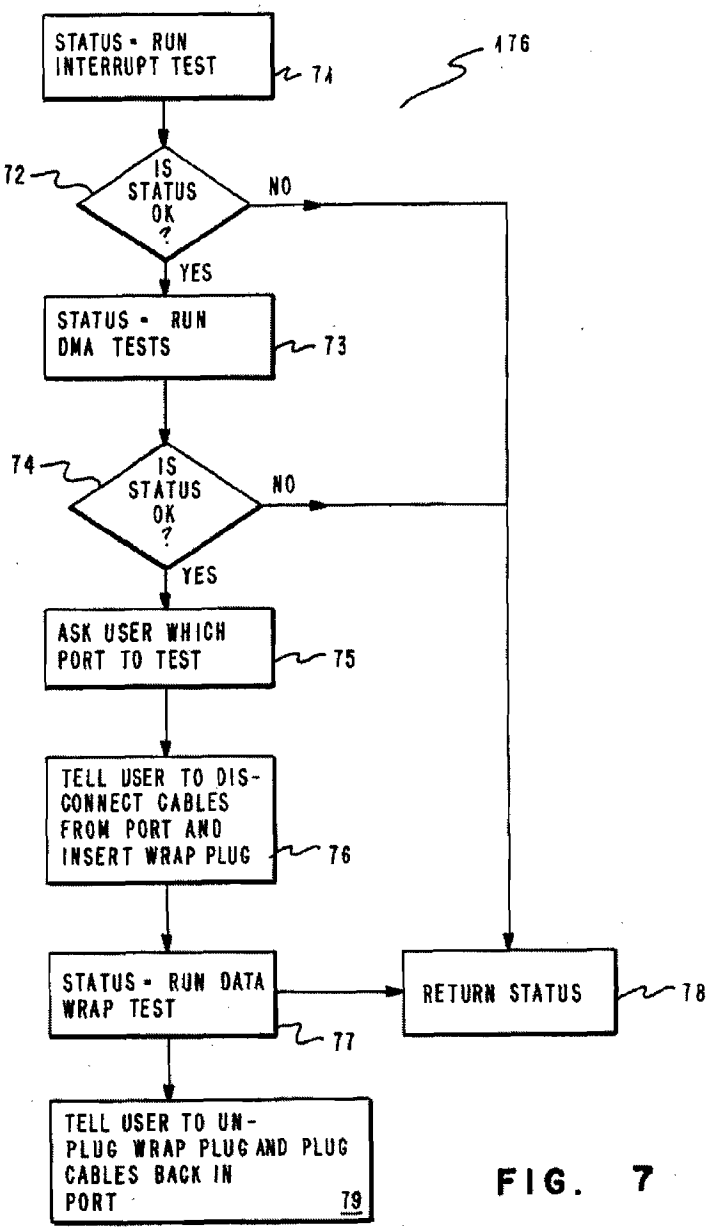

FIG. 7

Note that the status is not "OK" in block 72 or block 74, the flow returns status (block 78) and ends. Nowhere does *Benignus* teach or suggest **repeating** the application of each failed rule to configure the subject entity according to the target state specified in the failed rule when all the corresponding prerequisites are available. Therefore, even assuming, *arguendo*, that a person of ordinary skill in the art would have combined a set of prerequisite rules for testing data processing system components with the features recited in claim 1 of the '863 application, the combination still would not result in the present invention. The Office Action does not establish a *prima facie* case of

obviousness for instant claim 1. Therefore, Applicants respectfully request withdrawal of the obvious-type double patenting rejection.

III. 35 U.S.C. § 103, Alleged Obviousness of Claims 1-6 and 9

The Office rejects claims 1-6 and 9 under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Douglas et al.* (U.S. Patent No. 6,039,688) in view of *Benignus et al.* (U.S. Patent No. 4,888,771). This rejection is respectfully traversed.

Douglas teaches a therapeutic behavior modification program, compliance monitoring, and feedback system. A case advisor, such as a physician, may place a patient onto the system to help the patient make necessary lifestyle and behavior modifications. Patients are placed into categories and are assigned intensity levels. See col. 6, line 14, to col. 7, line 22. The case advisor also prescribes a recovery program level based on the categories. See col. 6, lines 27-39. The system then provides an interface that allows immediate patient access to the behavior modification program and helps monitor compliance with the program by prompting the patient to input data relating to his or her adherence to the program's parameters. The system provides feedback to the patient through the interface, which provides access to pertinent medical information, an online journal, an electronic calendar, online interactive group support sessions, and motivational multimedia presentations. See col. 2, line 22, to col. 3, line 9.

The Office Action acknowledges that *Douglas* does not teach that the target state of at least one rule is a prerequisite for the target state of at least one further rule or repeating the application of each failed rule to configure the subject entity according to the target state specified in the failed rule when all the corresponding prerequisites are available. The Office Action alleges that *Benignus* teaches that the target state of at least one rule is a prerequisite for the target state of at least one further rule at col. 9, line 1, to col. 10, line 43. The cited portion of *Benignus* appears to teach a diagnostic configuration management system for a data processing system. *Benignus* appears to teach a system checkout component that determines which prerequisite rule base to run when checking out a component in the data processing system. *Benignus* states:

> Whenever an option checkout is selected, the system checkout component first checks to see if there is a prerequisite rule base to run for the option. If there is, the

> system checkout component checks to see if that prerequisite option has a prerequisite rule base. This allows an endless number of options to be chained together and tested in the correct order independent of each other.

Benignus, col. 9, lines 38-45. However, the rules are rules for testing data processing system components. It is unclear how the Office proposes to combine a system for testing data processing system components with a therapeutic behavior modification program for human patients. Dependencies between a receiver card and an expansion card are in no way related to patient behavior.

The Office may not use the claimed invention as an "instruction manual" or "template" to piece together the teachings of the prior art so that the invention is allegedly rendered obvious. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Such reliance is an impermissible use of hindsight with the benefit of applicant's disclosure. *Id.* Therefore, absent some teaching, suggestion, or incentive in the prior art, *Douglas* and *Benignus* cannot be properly combined to form the claimed invention. As a result, absent any teaching, suggestion, or incentive from the prior art to make the proposed combination, the presently claimed invention can be reached only through an impermissible use of hindsight with the benefit of Applicant's disclosure a model for the needed changes. In other words, given only the cited prior art, a person of ordinary skill in the art would not have been motivated to combine testing rules in a diagnostic configuration management system for data processing system components (*Benignus*) with a therapeutic behavior modification program, compliance monitoring, and feedback system for human patients (*Douglas*).

Furthermore, *Benignus* does not teach or fairly suggest repeating the application of each failed rule to configure the subject entity according to the target state specified in the failed rule when all the corresponding prerequisites are available, as recited in claim 1, for example. In fact, it appears that in *Benignus*, the logic stops testing whenever a test fails. FIG. 7 of *Benignus* is reproduced above. Note that the status is not "OK" in block 72 or block 74, the flow returns status (block 78) and ends. Nowhere does *Benignus* teach or suggest **repeating** the application of each failed rule to configure the subject entity according to the target state specified in the failed rule when all the corresponding prerequisites are available. Therefore, even assuming, *arguendo*, that a person of

ordinary skill in the art would have combined a set of prerequisite rules for testing data processing system components with a program for modifying behavior of human patients, the combination still would not result in the present invention.

The applied references fail to teach or suggest each and every claim limitation. Therefore, the proposed combination of *Douglas* and *Benignus* does not render claim 1 obvious. Independent claim 9, as well as new independent claim 19, recites subject matter addressed above with respect to claim 1, and is allowable for similar reasons. Since claims 2-5, as well as new claims 11-18 and 20-24, depend from claims 1, 9, and 19, the same distinctions between *Douglas* and *Benignus* and the invention recited in claims 1, 9, and 19 apply for these claims. In addition, claims 2-5, 11-18, and 20-24 recite additional combinations of features not taught or suggested by *Douglas* and *Benignus*.

More particularly, with respect to claims 2-5, the Office Action simply states, "one of ordinary skill in the art would have readily recognized that Douglas and Benignus may obviously also teach the method steps of claim 1 as set forth in claims 2-5." Applicants respectfully disagree. Claims 2-5 recite **further** limitations, not just restating the method steps of claim 1. The Office Action proffers no analysis whatsoever as to why claims 2-5 are somehow obvious over the teachings of Douglas and Benignus. Therefore, the Office fails to establish a *prima facie* case of obviousness for claims 2-5. The rejection of claims 2-5 is improper and must be withdrawn.

As to the specific limitations of claim 2, for example, neither Douglas nor Benignus teaches or suggests repeating the application of each failed rule; therefore, the applied prior art cannot possibly teach a deadlock situation. New claims 13 and 20 recite subject matter addressed above with respect to claim 2 and are allowable for similar reasons.

With respect to new claims 11 and 17, neither *Douglas* nor *Benignus* teaches or suggests a subject entity that directly controls a resource. As to new claims 12, 18, and 24, neither *Douglas* nor *Benignus* teaches or suggests the at least one further rule does not include any information about the target states of the at least one rule that are a prerequisite for the target state of at least one further rule. In fact, *Benignus* states that prerequisite information is expressly listed for each option. The applied prior art does not

teach each and every claim limitation; therefore, the proposed combination of *Douglas* and *Benignus* does not render claims 11, 12, 17, 18, and 24 obvious.

IV. Conclusion

It is respectfully urged that the subject application is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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